

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/784,353 Confirmation No.: 2325
Applicant: Kenneth L. Miller
Title: METHOD FOR WAGERING
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Art Unit: 3714
Examiner: Ryan Hsu

Atty. Docket: 04-7131
Customer No. 63710

SUBMISSION IN REPLY TO OFFICE ACTION

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Commissioner for Patents
P.O. Box 1450
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Applicant hereby replies to the Office Action of July 11, 2007. Kindly amend the application as follows.

AMENDMENTS TO THE SPECIFICATION begin on page 2 of this paper.

AMENDMENTS TO THE CLAIMS begin on page 3 of this paper.

REMARKS/ARGUMENTS begin on page 11 of this paper.

AMENDMENTS TO THE SPECIFICATION

Please amend the paragraph at page 4, line 29 to page 5, line 25 (paragraph [0023] of publication 2005/0187000) as follows:

Referring again to Fig. 1, in a case where the player has wagered as indicated in Fig. 2, at step 18, the player has wagered that the first race 50 a certain horse will be won by horse number 1 (win each of races 1, 2, 5, 7 and 9, corresponding to pick(n) race 1 of 5 22), that the second race will be won by horse number 2 (race 2 of 5 36), that the fifth race will be won by horse number 2, that the seventh race will be won by horse number 15, and the ninth race will be won by horse number 1 , race 3 of 5 38, race 4 of 5 40, and race 5 of 5 42. If the first race (race 1 of 5, box 22) is won by the player's selected winner actually wins (step 24) the race 1 of 5 22, the player can relax and wait until the second race (race 2 of 5, step 36). However, if a player's selected winner loses (step 26) race 1 of 5 (box 22), then in step 28, the player may determine if there are still more than the Pick(n) number of races left [[28]]. Since the player here is playing a Pick 5, if his horse did not win (step 26) in race 1 of 5 22, there are still nine races left. The player can wager again (steps 14 and 16) and still try and select the winners of any five remaining races for the event.

AMENDMENTS TO THE CLAIMS

1. (Currently amended) A ~~method of wagering on horse races in an event having races,~~
~~the method comprising the steps of:~~
~~predetermining a quantity of the event's races to be included in a wager;~~
~~from among races at an event having a plurality of horse races,~~ allowing a player to
choose winners of each of a plurality of the event's races to be included in a unified ~~the~~ wager,
~~the choices available to the player permitting the player to choose horses in a non-consecutive~~
~~plurality of races from among wherein the player is required to choose a number of chosen races~~
~~equal to the predetermined quantity of the event's races;~~
~~allowing the player to select a winner for each of the chosen races, the selected winners~~
~~included in the wager;~~ and
paying the player if a ~~predetermined~~ number of the selected winners within the unified
wager win corresponding chosen races.
2. (Currently amended) The ~~method of wagering on horse races~~ of claim 1 wherein:
the player indicates multiple horses for at least one race of ~~predetermined quantity of the~~
~~event's races included in the wager is less than a total number of races in the event.~~
3. (Currently amended) The ~~method of wagering on horse races~~ of claim 1 wherein:
the choices available to the player permit the player to choose horses in ~~predetermined~~
~~quantity of the event's races is five~~ non-consecutive races.
4. (Currently amended) The ~~method of wagering on horse races~~ of claim 1 wherein:
~~paying the player's unified wager pays only if the predetermined number of selected~~
~~winners win corresponding chosen races comprises paying the player if all of the selected~~ horses
~~winners win corresponding chosen races.~~

5. (Currently amended) The method of ~~wagering on horse races~~ of claim 1 wherein:
the player's unified wager pays if fewer than all the predetermined number of selected
horses win ~~ners is less than a total number of winners for the chosen~~ their races.

6. (Currently amended) A ~~method of wagering on horse races in an event having a~~
~~plurality of races, the method performed by a player to wager on horse racing, comprising the~~
~~steps of:~~

~~receiving information specifying a predetermined number of event races to be included in~~
~~a wager;~~

from among races at an event having a plurality of horse races, selecting one or more
horses in each of a plurality of event races to be included in a unified the wager, the choices
available to the player permitting the player to choose horses in a non-consecutive plurality of
chosen races from among the number of selected races equal to the predetermined number of
event races to form the unified wager;

~~selecting a winner for each of the selected races in the wager; and~~

~~receiving a payout if a predetermined number of selected~~ horses within the unified wager
perform consistent with the unified wager in winners win corresponding chosen races.

7. (Currently amended) The method of ~~wagering on horse races~~ of claim 6 further
comprising the step of: wherein the selected races are not run consecutively
receiving from the player a bet on multiple contestants for a single contest.

8. (Currently amended) The method of wagering on horse races of claim 6 further
comprising the step of: wherein the wager is for at least one dollar
paying the player if at least one of the selected contestants places in a corresponding
selected event contest.

9. (Currently amended) A computer assisted method ~~for administering betting on a plurality of races within a racing event using a computer for assistance~~, comprising the steps of:

publishing race information associated with a [[the]] racing event ~~to a plurality of players for use in wagers;~~

~~establishing a predetermined quantity of the event races to be included in wagers;~~

receiving from each of a plurality of players ~~respective a first selection of a subset of the plurality of races within the racing event from each of the plurality of players, the number of races in the first selection corresponding to the predetermined quantity;~~ receiving a second selections of predicted winners for each of a plurality of races at the racing event ~~from each of the plurality of players, each of the predicted winners corresponding to at least one of the races in the first selection, the selections available to each player permitting the player to choose horses in a non-consecutive plurality of races from among the event's races, the first and second selections of each player included in a unified respective wager corresponding to that respective player;~~

receiving from each of the plurality of players a bet associated with the wager corresponding to that player;

pooling at least a portion of each bet to form a pool;

receiving results from ~~each~~ racess within the racing event;

identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected ~~each~~ predicted winners in their respective second selections ~~for each race within the first selection;~~ and

sending at least a portion of the pool to one or more identified winning players.

10. (Currently amended) The computer assisted method of claim 9 wherein:

~~the first selection of the subset of the plurality of races and the second selection of predicted winners for each race in the second selection~~ is associated with a game card.

11. (Currently amended) The computer assisted method of claim 10 wherein:
the number of races that must be selected by each player is established by a sponsor of the wagering system ~~data on the game card is transferred to the computer.~~
12. (Currently amended) The computer assisted method of claim 9 wherein:
the players are further provided the opportunity to indicate multiple horses for at least one race ~~results from each race within the racing event are input into the computer.~~
13. (Previously presented) The computer assisted method of claim 9 wherein:
for at least one player of the plurality of players the first selection of races is a subset of nonconsecutive races.
14. (Currently amended) The computer assisted method of claim 9, wherein:
~~A wager in an event having races, the wager comprising a bet that a particular entry selected by a bettor in each of a plurality of the races will be a winning entry, the players respectively select a single horse for each selected race~~ plurality of races comprise a predetermined number of races that are selected by the bettor.
15. (Currently amended) ~~A method of accepting bets on an event having a plurality of event contests, the method comprising~~ the steps of:
~~selecting a predetermined quantity of the event contests for a wager;~~
receiving from a user a selection of event contests, from among the plurality of contests ~~within an event contests, to be included in the wager, the number of selected event contests corresponding to the predetermined quantity of event contests; and receiving from the user a selection of contestants in corresponding to each of a plurality of the selected event's contests, and establishing a unified wager based on the outcome of the selected contestants, the selections available to the user include selecting contestants from a non-consecutive plurality of contests within the event; and~~

paying the user a winning on the unified wager based on the performance of the selected contestants in the selected contests.

16. (Currently amended) The method of claim 15 further comprising the step of:
receiving from the user a bet on multiple ~~the selected~~ contestants for a single contest.

17. (Previously presented) The method of claim 15 further comprising paying the user if a predetermined number of the selected contestants wins a corresponding selected event contest.

18-21. (Canceled)

22. (Currently amended) The method of claim 15 wherein:
the user's unified wager pays if fewer than all selected contestants win their respective
~~the predetermined quantity is less than a total number of contests in the event.~~

23. (Currently amended) The method of claim 15 further comprising the step of:
after one or more contests are decided, receiving a further unified wager on the terms of
claim 15 from a user based on the remaining contests of the event ~~paying the user if a preselected~~
~~quantity of the selected contestants wins a corresponding selected event contest.~~

24. (Previously presented) The method of claim 15 further comprising:
paying the user if at least one of the selected contestants places in a corresponding
selected event contest.

25. (Currently amended) An apparatus ~~system for betting on an event having a plurality~~
~~of event contests~~, comprising:

~~a processor operable to determine a predetermined quantity of the event contests for a~~
~~wager; and~~

a processor having an interface ~~coupled to the processor and~~ operable to:

receive from a user ~~a selection of event contests, from among the plurality of event contests, to be included in the wager, the number of selected event contests corresponding to the predetermined quantity of event contests;~~ receive from the user a selection of contestants in corresponding to each of a plurality of contests at the selected event contests, the interface permitting the user to select contestants in a non-consecutive plurality of contests from among the event contests on which to wager, the selected contestants forming a unified wager; and
~~wherein~~ the processor being ~~[[is]]~~ further operable to determine whether the unified wager is a winning wager, based at least in part on whether a predetermined number of the selected contestants that win won the corresponding selected event contests, if the user is a winner.

26. (Currently amended) The apparatus system of claim 25, the interface further operable to receive from the user a bet on the selected contestants.

27. (Currently amended) Logic embodied in a computer readable medium, the logic computer readable medium comprising code operable to:

~~select a predetermined quantity of the event contests for a wager;~~
receive from a user a selection ~~of event contests, from among the plurality of contestants in contests at an event contests, to be included in the wager, the number of selected event contests corresponding to the predetermined quantity of event contests; and~~ receive from the user a selection of contestants in corresponding to each of several the selected contests within an event contests, the selection available to the user including selecting contestants from a non-consecutive plurality of contests within the event to form a unified wager; and
determine whether the user is a winner, based on whether a predetermined number of selected contestants within a unified wager won the corresponding selected event contests, if the user is a winner.

28. (Currently amended) The logic of claim 27, further computer readable medium comprising code ~~further~~ operable to receive from the user a bet on the selected contestants.

29. (Currently amended) The method ~~of wagering on horse races~~ of claim 6 further comprising the step of:

placing a bet on the selected winners.

30. (Currently amended) A method ~~for receiving bets on an event having a plurality of event contests~~, comprising the steps of:

~~predetermining a quantity of event contests for a betting pool;~~

receiving a first wager associated with a first player, wherein the first wager identifies a ~~first plurality of event contests selected by the first player~~, a winner for each of ~~a the~~ first plurality of event contests selected by the first player, and a first wager amount, the choices available to the first player including choosing winners of a non-consecutive plurality of contests from among the contests of the event to form a first unified wager ~~wherein a number of event contests in the first plurality is equal to the predetermined quantity;~~

receiving a second wager associated with a second player, wherein the second wager identifies a ~~second plurality of event contests selected by the second player~~, a winner for each of ~~a~~ [[the]] second plurality of event contests selected by the second player, and a second wager amount, the choices available to the second player including choosing winners of a non-consecutive plurality of contests from among the contests of the event to form a second unified wager ~~wherein a number of event contests in the second plurality is equal to the predetermined quantity;~~

adding the first wager amount and the second wager amount to ~~a~~ [[the]] betting pool; and

determining at least one winning player for the pool, based at least in part on correct identification of ~~wherein each winning player is associated with a wager that correctly identifies~~ a winners for each of the event contests selected by that player within that player's unified wager.

31. (Previously presented) The method of claim 30, wherein:
at least one of the event contests selected by the first player is not included in the plurality of event contests selected by the second player.

32. (Currently amended) The method of claim 30, wherein:
the first player selects contest winners after completion of the first contest of the event
~~contests in the first plurality of event contests comprise non-consecutive event contests within~~
~~the event.~~

33. (Currently amended) The method of claim 30, further comprising the step of:
receiving a third wager associated with a third player after an event contest in one of the first plurality of event contests and the second plurality of event contests has begun, wherein the third wager identifies a third plurality of ~~event contests selected by the third player,~~ a winners for each of the third plurality of event contests, and a third wager amount, ~~wherein a number of event contests in the third plurality is equal to the predetermined quantity.~~

34. (Previously presented) The method of claim 30, further comprising calculating a payout amount for the at least one winning player based on a total of the betting pool.

35. (Previously presented) The method of claim 34, further comprising initiating a payout of the payout amount to the at least one winning player.

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of July 11, 2007 and respectfully requests reconsideration of the application.

Claims 1-17 and 22-35 are now pending, a total of 31 claims. Claims 1, 6, 9, 15, 25, 27 and 30 are independent.

All claims now pending recite language similar to (though not necessarily identical to) the following:

receiving from a user a ... selection of contestants in a plurality of the event's contests, and establishing a unified wager based on the outcome of the selected contestants, the selections available to the user include selecting contestants from a non-consecutive plurality of contests within the event

The July 2007 Office Action concedes that this language is sufficient to distinguish all references.

I. Enablement

An unnumbered paragraph at page 2 of the Office Action starts with the “enablement” form paragraph. However, the basis for the remainder of this paragraph is unclear.

A. Legal Standard for Enablement

The test for “enablement” is “undue experimentation.” *In re Wands*, 858 F.3d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *Id.* The enablement requirement may be met by the knowledge in the art, even if it is not in the specification. *Falkner v. Inglis*, 448 F.3d 1357, 1365, 79 USPQ2d 1001, 1006 (Fed. Cir. 2006). “[A] patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.” *Koito Mfg. Co. v. Turn-Key Tech LLC*, 381 F.3d 1142, 1156, 72 USPQ2d 1190, 1200 (Fed. Cir. 2004).

B. Procedural Requirements for Setting Forth an Enablement Issue

MPEP § 706.03(c), form paragraphs 7.31.02, note 3, requires that an “enablement” rejection discuss the *Wands* factors, and requires the Examiner to comply with MPEP

§§ 2164.01(a) and 2164.04. MPEP § 2164.04 reads as follows, in pertinent part (citations and quotations omitted):

2164.04 Burden on the Examiner Under the Enablement Requirement

... the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

[T]he analysis and conclusion of a lack of enablement are based on the [*Wands*] factors discussed in MPEP § 2164.01(a) and the evidence as a whole... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

C. The Office Action Is Procedurally Inadequate to Raise Any Enablement Issue

The Office Action observes several different embodiments that fall within the claim language. The Office Action then simply ignores all instructions in the MPEP. The Office Action never even mentions “undue experimentation.” The Office Action never mentions the *Wands* factors. The Office Action makes none of the showings and considers none of the factors that are procedurally required by MPEP § 2164.04 to bring any rejection into existence. No rejection exists.

The Office Action merely asserts that certain information is not expressly in the specification. The Office Action’s observations are irrelevant. *Falkner*, 448 F.3d at 1365, 79 USPQ2d at 1006. No rejection exists.

II. Pages 3-6

A. Legal Standard for Anticipation

There is no anticipation “unless all of the same elements are found in exactly the same situation and united in the same way ... in a single prior art reference.” *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984). It is error to “[treat] the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships

set forth in the claims...” *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984).

B. Procedural Requirements for Setting Forth an Anticipation Issue

MPEP § 2131 explains an Office Action’s duties under § 102:

2131 Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim.

It is the Examiner’s burden to make all required showings on all limitations of a claim, including the interrelationships within the claim. *Ex parte Berg*, 2002 WL 32346092 at *2, <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&fINm=fd020456> at 4 (BPAI Feb. 6, 2003) (“the examiner must present a full and reasoned explanation of the rejection in the statement of the rejection, specifically identifying underlying facts and any supporting evidence, in order for appellants to have a meaningful opportunity to respond,” emphasis in original). It is not an applicant’s duty to guess at the Examiner’s position. *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000).

C. Applicant Requests a Clear and Explicit Comparison of All Claim Language to the References

This Attorney concurs with the observations of the previous attorney, that previous Office Actions have been either imprecise or incomplete. As a first example, this attorney notes that the first comparison of the claim language “allowing a player to choose the event’s races to be included in a wager” came very late in prosecution. As a second example, it appears that a first instance of “race” in the claim was compared to one thing in the references, and a second instance of “race” compared to something else, or else “horse” and “race” of the claims were compared to the same thing in the references. It’s not clear which. The Office Actions have not been sufficiently clear to communicate the Examiner’s view or make the Examiner’s position clear. Applicant suggests that completing a table such as the following may be helpful to ensure precision:

event	
race	
winner	
unified wager	
non-consecutive plurality of races ¹	
paying the player ... within the unified wager	

¹It is important that the “races” here must be the same as the “races” elsewhere in the claims, and kept distinct from the “horses” or the “event.”

Applicant respectfully requests that there be no further “piecemeal examination.”

III. Pages 9-10

The unnumbered paragraph at pages 9-10 concedes that no reference shows non-consecutive races. The Office Action then states “It would not be beyond one of routine to recognize any combination of racing events could be included in a multiple race wager as taught above.” “Not beyond one of routine” is not now and never has been an authorized test for obviousness. After an element – a unified wager based on non-consecutive races – has been conceded to be absent from the art, there can be no obviousness. If any obviousness issue is raised in the future, Applicant requests that the Examiner follow the Office’s guidance set forth in MPEP §§ 2143-2143.03.

IV. Designation of Paragraphs in the Office Action

The Examiner’s attention is drawn to MPEP § 707.07(k):

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

The examiner’s attention is also drawn to the menu in Microsoft Word, Format > Bullets and Numbering, which gets to this dialog box:

Bullets and Numbering

☐ Bulleted ☒ Numbered ☐ Outline Numbered ☐ List Styles

None

1. List Number
2. List Number
3. List Number

1) _____
2) _____
3) _____

I. _____
II. _____
III. _____

A. Exhibit List~
B. Exhibit List~
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c) List alpha 2~

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The Examiner will observe that this Reply paper is remarkably less clear than it would have been had there been paragraph numbers in the Office Action to which to refer.

V. Withdrawal of Previous Remarks

The claims as now pending are broader in some respects than previous claims. Applicant intends that the claims as now pending be interpreted under the ordinary interpretation understood in the art. Applicant hereby rescinds, and no longer intends that the claims be limited by, any assertion, statement, argument, amendment or other action in this patent application, or any application whose file history is available for use in interpreting any patent issuing on this application, that might be taken to be a surrender or disclaimer of any subject matter from the scope of any claim. No such assertion, statement, argument, amendment or other action in this application or in any such available application should be taken as a surrender or disclaimer from, and may not be used to interpret, any claim of this patent, or any claim of any patent to which such applications' file histories may be pertinent.

Applicant hereby requests that the Examiner re-visit any previous surrender, disclaimer or characterization of claims, and re-visit any prior art that may have been avoided or intended to be avoided by such surrender, disclaimer or characterization.

VI. Conclusion

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this reply timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 04-7131.

Respectfully submitted,
CANTOR INDEX L.L.C.

Dated: December 17, 2007

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